

D2487

Remarks

Reconsideration of rejected claims 1-30 is respectfully requested.

In the Office action dated June 1, 2004 (application Paper No. 6), the Examiner objected to the drawings and rejected all pending claims 35 USC § 102(e). The Examiner's objection and rejection will be discussed below in the order appearing in the Office action.

Objection to the Drawings

The Examiner first objected to the drawings, stating that the "limitations of claim 1 must be shown or the feature(s) canceled from the claim(s)". In response, applicants believe that the drawings as submitted (and subsequently also shown in the formal drawings filed May 14, 2002) do indeed show every "limitation of claim 1". Referring to claim 1 and FIG. 3, there is illustrated in FIG. 3 a "first cache" 60, a "second cache" 62, a "control unit" 66 and a "switching mechanism" 67. Applicants believe that this illustration is more than sufficient to support the subject matter/features of pending claim 1. Applicants therefore respectfully request the Examiner to reconsider this objection and find the drawings as filed to be acceptable.

35 USC § 102(e) Rejection - Claims 1-30

The Examiner then rejected all pending claims 1-30 under 35 USC 102(e) as being anticipated by US Patent 6,094,677 (Capek et al). In particular, the Examiner cited Capek et al. as teaching "a first cache" (insertion repository 22), "a second cache" (server 26), "a control unit" (insertion manager 20), and "a switching mechanism" (specific element of Capek et al. not given).

D2487

In response, applicants assert that there are distinct differences between the subject matter of Capek et al. and the subject matter of the present invention, where Capek et al. is limited in its teaching to "inserting" an advertisement stream to an end-user who is waiting for another file to download. There is no "decision" made in Capek et al. regarding the insertion of an alternative stream "before, during or after" a streaming multimedia file has been presented to an end-user. Indeed, the purpose of Capek et al. is to use the "waiting time" prior to the download to transmit an ad to the end-user. Such an "alternative multimedia file" would never be transmitted to an end-user after receiving the streaming the multimedia file, where this scenario is quite possible in the system and method of the present invention as defined by the rejected claims. Indeed, an alternative multimedia file may be inserted "during" the streaming process, with the real-time received multimedia file being cached and then transmitted once the alternative file is completed (see, for example, step e) of claim 22).

Referring to FIG. 3 of the present application, it is clear that the "switching mechanism" (switch 67) includes three separate inputs: streaming multimedia, a cached portion of the streaming multimedia, or a cached alternative multimedia file. Claim 1 has been amended to clearly state that there are three separate possibilities. Such is not the case with Capek et al. - either an advertisement file is "inserted" while a multimedia file is downloading or it isn't. There is no "switching mechanism" in Capek et al. as defined in rejected independent claim 1. There is no "resumption" of transmission of the streaming multimedia file (step f) of claim 21) once the alternative file is finished in the Capek et al. arrangement, since the requested multimedia file is not accessed until the "advertisement" file is completed.

Based on this discussion and the above-noted amendments to the pending claims, applicants assert that Capek et al. cannot be found to "anticipate" the subject matter of claims 1-30 - Capek et al. is clearly limited to inserting an advertisement in a communication line as a file is being downloaded for the end-user ("the insertion is presented to the client 24 during the delay while the program material is being retrieved from the server 26"; column 7, lines 23-25). Moreover, the "control mechanism" of

D2487

Capek et al. is a software trigger available to the end-user to "control" the playing of the ad -- the control is not in the "network" and used to control transmission. Applicants therefore respectfully request the Examiner to reconsider this rejection and find all claims 1-30, as amended, to now be in condition for allowance.

Applicants believe that the case, in its present form, is now in condition for allowance and respectfully request an early and favorable response from the Examiner in that regard. If for some reason or other the Examiner does not agree that the case is ready to issue and that an interview or telephone conversation would further the prosecution, the Examiner is invited to contact applicant's attorney at the telephone number listed below.

Respectfully submitted,

Marc W. Kauffman
Jonathan Fellows

By:

Wendy W. Koba
Wendy W. Koba
Reg. No. 30509
Attorney for applicant
610-346-7112

Date:

9/1/04